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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,723	10/07/2003	Michael S. South	PHA 4159.33	2648
321	7590	06/15/2005	EXAMINER	
SENNIGER POWERS LEAVITT AND ROEDEL ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/680,723

Applicant(s)

SOUTH ET AL.

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-11, 17-19, 25-27, 33-49 and 51-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 17-19, 25-27, 33-37 and 54-107 is/are allowed.
- 6) ☐ Claim(s) 38-49 and 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response, which included amendment to claims 1-11, 17-19, 25-27, 33-49, 51-54 and 70, filed on 3/1/2205, is made of record. Claims 1-11, 17-19, 25-27, 33-49 and 51-107 are now pending.

In view of applicants' filing of terminal Disclaimers, the obviousness double patenting rejections over US 6,653,316 and 6,750,342 have been obviated. In view of applicants amendment to claims of copending application, the provisional obviousness type double patenting rejection over 10/276,171 has been obviated. However, the following rejections apply:.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating thrombosis, does not reasonably provide preventing such thrombosis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant claims 38-48 are drawn to "treating or preventing" several thrombotic condition in mammal .The scope of the claims includes not only include treating also "**prevention**" of thrombotic condition related diseases which is not adequately enabled solely based on the activity of the compounds provided in the specification at pages

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182-187. The instant compounds are disclosed to have protease inhibitory activity which relates to inhibition of thrombin and it is recited that the instant compounds are useful in or “preventing” thrombotic condition of several diseases, for which applicants provide no competent evidence. “To prevent” actually means *to anticipate or counter in advance, to keep from happening etc.* (as per Webster's II Dictionary) and there is no disclosure as to how one skilled in the art can reasonably establish the basis and the type of subject to which the instant compounds can be administered in order to have the “prevention” effect. There is no evidence of record which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the disease(s) or disorder(s) claimed herein. Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) wherein it is emphasized that ‘a claimed invention must have a specific and substantial utility’. The disclosure in the instant case is not sufficient to enable the instantly claimed ‘preventive’ effect solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. See Rauch et al., (PubMed Abstract enclosed) wherein with regards to antithrombotic therapies, it is stated that “Current antithrombotic therapies available as long-term treatment for patients with cardiovascular disease are often not effective enough to prevent acute thrombotic events and deterioration of atherosclerosis”. Also, Van Aken et al., (PubMed Abstract enclosed) with regards to therapeutic approach of thromboembolic disorders, expresses that ‘thrombin inhibitors have limitations because their pharmacokinetics and anticoagulant effects are

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unpredictable'. (Only a few of the claimed diseases are discussed here to make the point of an insufficient disclosure, it does not definitely mean that the other diseases meet the enablement requirements). In addition, based on the claim language, it appears that applicant's compounds are effective for "abnormal thrombosis". Specification has no teaching as to this as assays relied upon are for thrombin or related factor inhibition.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

- 1) The nature of the invention: Therapeutic use of the compounds in preventing diseases that require thrombosis inhibitory activity.
- 2) The state of the prior art: A recent publication expressed that the pharmacokinetics and anticoagulant effects of thrombin inhibitors are unpredictable.
- 3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for the 'preventive' effect and or treating any or all condition of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of

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enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show preventive effect thrombotic condition and the state of the art is that the effects of thrombin inhibitors are unpredictable.

6) The breadth of the claims: The instant claims embrace not only treatment but also the **prevention** of diseases.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards 'preventing' the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

Claims 51-53 are rejected under U.S.C. 112, first paragraph, because the specification while being enabling for treating thrombosis, does not reasonably provide enablement for treating or preventing any or all disorders generically embraced in the

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claim language. The specification does not enable any physician skilled in the art of medicine, to use the invention commensurate in scope with these claims. The factors to be considered in making an enablement rejection have been summarized above.

The instant claims are drawn to "treating or preventing a TF VIIA mediated disorder" in general. The scope of the claims includes treating or preventing any or all disorders mediated by TF VIIA bition including those yet to be discovered as due said mode of action for which there is no enabling disclosure. In addition, the scope of these claims includes treatment of various diseases, which is not adequately enabled solely based on the activity of the compounds provided in the specification at pages 177 and 260-261

The instant compounds are disclosed to have TF VIIA inhibitory activity and it is recited that the instant compounds are therefore useful in treating any or all disorders for which applicants provide no competent evidence. It appears that the applicants are asserting that the embraced compounds because of their mode action as TF VIIA inhibitor that would be useful for all sorts of disorders. However, the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases thrombotic disorders are very difficult to treat and despite the fact that there are many drugs, which can be used for inhibiting thrombin.

The scope of the claims involves all of the millions of compounds of claim 1 as well as the thousand of disorders generically embraced in the claim language and different underlying causes. Thus, the scope of claims is extremely broad.

No compound has ever been found to treat or prevent all types disorders generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "compound" is contrary to our present understanding of modern medicine. Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. See *Golino Thrombosis Research*, 106: V257-V265, 2002.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.



- 1) The nature of the invention: Therapeutic use of the compounds in treating or preventing disorders that require TF VIIA inhibitory activity.
- 2) The state of the prior art: A recent publication expressed that the TF VIIA inhibition effects are unpredictable and are still exploratory. See Golino cited above
- 3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for r treating any or all condition of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).
- 4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating any or all condition and the state of the art is that the effects of TF VIIA inhibitors are unpredictable.
- 6) The breadth of the claims: The instant claims embrace any or all disorders mediated by TF VIIA
- 7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant

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case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was 'filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-49 and 51-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-16, 20-24, 28-32 and 40-49 of copending Application No. 10/680,873. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition and the method of use claimed in the instant application are also embraced in the claims of the copending application 10/680,873.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

Claims 1-11, 17-19, 25-27, 33-37 and 54-107 would be allowable as prior art search in the relevant art area did not teach or suggest the compound embraced in the claims 1-11, 17-19, 25-27, 33-37 and 54-107.

#### ***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661.

The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of

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this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

*Venkataraman Balasubramanian*  
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6/10/2005